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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,089	06/20/2005	Per-Ingvar Branemark	2816-4	6438
616 7590 02/26/2007 THE MAXHAM FIRM 9330 SCRANTON ROAD, SUITE 350 SAN DIEGO, CA 92121			EXAMINER WOODALL, NICHOLAS W	
			ART UNIT 3733	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			02/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/540,089

Applicant(s)

BRANEMARK, PER-INGVAR

Examiner

Nicholas Woodall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/27/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-34 is/are rejected.
- 7) ☒ Claim(s) 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment received on 11/27/2006.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the slots connecting to the cavity as stated in claim 11 must be shown or the feature(s) canceled from the claim(s). The examiner is upholding the drawing objection from the previous office action. Figure 2 of the application does not clearly show the slots connecting to the cavity of the device. There is an obvious space between the slots and the cavity in Figure 2 of the application. Furthermore, the examiner believes the figures of the application do not facilitate the understanding of the invention. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheets should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date

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of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11-26 and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (U.S. Patent 6,402,757) in view of Branemark (U.S. Patent 5,171,284).

Regarding claims 11-14 and 34, Moore discloses a device comprising a generally cylindrical anchor portion (46), a cavity (49), and a number of slots (32). The anchor portion is formed with an insertion end (34) and includes an external thread (48). The slots (32) are defined by a leading and trailing slot wall and relate to the rotation of the fixture (see Figure 1 below). The leading and trailing slot walls are shown to be at an angle with the radial direction of the fixture and slopes obliquely forward in the direction of rotation. The leading and trailing slot walls are shown to be parallel to each other. Moore discloses the invention as claimed except for the slots connecting to the cavity. Branemark teaches a device having slots that connect to the cavity of the fixture in order to greatly reduce the risk of concentrated stress in the device (column 3 lines 54-

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62). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the slots in Moore to connect with the cavity in view of Branemark in order to reduce the risk of concentrated stress in the device.

Regarding claims 15-20, the combination of Moore and Branemark disclose the invention as claimed except for the slot walls being at an angle of 20-40 degrees or 27-33 degrees with relation to the radial direction. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to manufacture the device of Moore modified by Branemark wherein the slot walls have an angle of 20-40 degrees or 27-33 degrees with relation to the radial direction, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

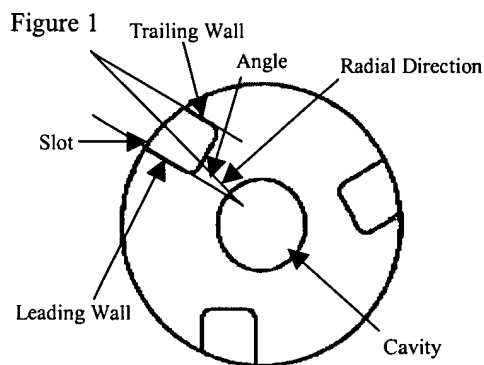
Regarding claims 21-26, the combination of Moore and Branemark disclose the invention as claimed except for the device having 3-10 slots or 5-7 slots. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Moore modified by Branemark to have 3-10 slots or 5-7 slots, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claims 30-33, the combination of Moore and Branemark disclose the invention as claimed except for the width of the slot at the radially outer end of the slot corresponds to 15-35 percent of the peripheral distance between two slots on the outside of the fixture. It would have been obvious to one having ordinary skill in the art

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at the time the invention was made to manufacture the device of Moore modified by Branemark wherein the slots have a width at the radial outer end of the slot corresponds to 15-35 percent of the peripheral distance between two slots on the outside of the device, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 34, the combination of Moore and Branemark disclose the invention as claimed except for the device being made from titanium. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Moore modified by Branemark from titanium, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.



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5. Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (U.S. Patent 6,402,757) in view of Branemark (U.S. Patent 5,171,284) further in view of Guedj (U.S. Patent 5,871,356).

The combination of Moore and Branemark discloses the invention as claimed except for the cavity widening conically towards the insertion end. Guedj teaches a device with a cavity having a truncated portion widening at the insertion end (column 3 lines 15-18) in order to guide the bone shavings (column 3 lines 11-14). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Moore modified by Branemark with a cavity having a truncated portion that widens towards the insertion end in view of Guedj in order to guide the bone shavings.

Allowable Subject Matter

6. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 11/27/2006 have been fully considered but they are not persuasive. Regarding the applicant's argument that Moore does not disclose slots wherein the radially outermost part of the trailing slot wall defines an angle with the radial direction and slopes obliquely forwardly from within and outwardly in said direction of rotation. The examiner has included Figure 1 above to help further show the reference having the limitations discussed above. As can be seen by the figure, Moore

shows the device having slots wherein the radially outermost part of the trailing slot wall defines an angle with the radial direction and slopes obliquely forward from within and outwardly in the direction of rotation as stated in column 5 lines 1-16.

Regarding the applicant's argument that Moore does not disclose a generally cylindrical anchoring portion forward with an insertion end and having an external thread. The claim only requires the anchor portion to be generally cylindrical, which Moore clearly discloses. Furthermore, the applicant's Figure 1 shows a tapered portion at the insertion end of the fixture.

Regarding the applicant's argument that Moore does not disclose a number of through penetrating slots extending from the insertion end, wherein each slot connects the cavity with the outside of the anchoring portion. The examiner agrees that Moore does not disclose this feature. Therefore, the examiner combined the reference of Moore with the teachings of Branemark in the previous office action, as well as in this office action, wherein Branemark teaches having the slots extend through to the cavity in order to reduce the risk of concentrated stress on the device.

Regarding the applicant's argument that the cavity of Moore is not disclosed to facilitate the insertion of the device, the functional limitations do not impose any structural limitations on the claims distinguishable over Moore, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference.

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Kalman v. Kimberly Clark Corp., 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Regarding the applicant's claims that Branemark fails to supply the structure not shown or suggested by Moore. The examiner believes Moore shows or suggests the structural limitations discussed above but fails to show or suggest the slots connect the cavity to the outside of the anchoring portion as discussed above. The examiner combined the disclosure of Moore with the teachings of Branemark as discussed above and in the previous office action in order to provide the device of Moore with slots that connect the cavity to the outside of the anchoring portion.

Regarding the applicant's argument that Guedj does not supply the limitations of claim 11, the examiner has explained above and in the previous office action that the limitations of claim 11 are met by the combination of Moore and Branemark. The teachings of Guedj were combined with the combination of Moore modified by Branemark in order to provide the device with a cavity that widens conically in a direction towards the insertion end as discussed above and in the previous office action.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER

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